

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 6

#### REMARKS

##### Change of correspondence address

Please note that the correspondence address for the present patent application has been changed in conjunction with a change in correspondence address form filed herewith. Therefore, subsequent correspondence is requested to be sent to the new correspondence address.

##### Organization of office action response

The present office action response is organized by claim. Each rejection pertaining a given claim is thus discussed in relation to that claim. Applicant very respectfully requests that the Examiner consider all the claims individually, as Applicant believes that many of them are independently patentable, regardless of the patentability of their base independent claims. That is, Applicant has discussed the separate patentability of a lot of the dependent claims, and asks that these dependent claims be given as careful consideration as the independent claims from which they depend.

##### Claim 1

Claim 1 has been amended so that each mobile wireless console manages the resource by "directly" communicating wirelessly with the resource. As such, claim 1 is now substantially limited in the same way that dependent claim 5, now cancelled, was. Therefore, Applicant discusses the patentability of claim 1 with respect to McAlear (6,754,710) in view of Chan (6,760,759), since claim 5 had been rejected under 35 USC 103 as being obvious over McAlear in view of Chan.

Applicant strongly contends that McAlear is not properly combined with Chan to yield the system of claim 1, in which the mobile wireless console *directly* communicates wirelessly with the resource, for three separate reasons. First, McAlear has not been considered in its entirety,

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 7

including suggestions therein that teach away from combination with Chan. Second, modifying McAlear in view of Chan changes the principle of operation of McAlear. Third, modifying McAlear in view of Chan destroys the intended functionality of McAlear. Each of these reasons is now specifically discussed.

*McAlear was not considered in its entirety and McAlear teaches away from claimed invention*

First, black letter law states that a "prior art reference must be considered in its entirety, i.e., as a whole, *including portions that would lead away from the claimed invention.*" (MPEP 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1983)). Reading McAlear in its entirety leads one of ordinary skill within the art to conclude that direct wireless communication is not to be achieved. McAlear clearly shows that indirect wireless communication is to be achieved between the mobile wireless console and the resource. For instance, in FIG. 2 thereof, there is an intermediating wireless access protocol (WAP) gateway in between the wireless console and the resources to be managed. Nowhere in McAlear is it suggested that its invention can be achieved without using this gateway, where the gateway enables the wireless console to *indirectly*, and not directly as in the claimed invention, communicate wirelessly with the resource. The Examiner cannot utilize one part of McAlear without considering the entirety of McAlear. That is, even if another reference, such as Chan, teaches direct wireless communication, that does not mean that the teachings of McAlear as a whole can be ignored, since McAlear must be considered in its entirety. And McAlear quite simply requires indirect wireless communication, in contradistinction to the invention.

The issue, in other words, is not that McAlear teaches the claimed invention, but is silent as to the type of wireless communication used, such that Chan can then be relied upon for this aspect of the claimed invention (i.e., to show direct wireless communication). Rather the issue is that McAlear, *in its entirety*, teaches the claimed invention, but that it *requires* the use of indirect wireless communication. So it is not a simple matter of finding another reference that teaches

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 8

direct wireless communication, as Chan does, because McAlear requires indirect wireless communication, and McAlear must be considered in its entirety. Chan is thus not properly combined with McAlear to yield the claimed invention.

Applicant provides one more way of looking at this issue, with a very diagrammatical approach. Say all of the limitations except for the direct wireless communication limitation of claim 1 are labeled as element A, and the direct wireless communication limitation of claim 1 is limited as element B. Now, McAlear teaches A, but not B. If McAlear was silent as to element B, then the Examiner would be correct in adding Chan into the mix as adding element B to yield the claimed invention. However, what is going on here is that McAlear is *not* silent as to element B; rather McAlear in its entirety specifically says that element B is not to be done. Therefore, adding Chan with its element B is improper, because it ignores McAlear's teaching as a whole that element B is not to be accomplished. Considering McAlear as a whole thus means that Chan is not properly combined with McAlear – McAlear explicitly teaches away from combining Chan with McAlear in the way the Examiner wants to do.

*Combining Chan with McAlear changes the principle of operation of McAlear*

Second, black letter law also states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings are not sufficient to render the claims *prima facie* obvious.” (MPEP 2143.01, citing *In re Ratti*, 123 USPQ 349 (CCPA 1959)) The Ratti decision is very informative in this regard. In Ratti, the claimed invention required resiliency to operate, whereas one of the prior art references relied upon required rigidity to operate. The CCPA held that the suggested combination of references “would require a substantial reconstruction and redesign of the elements shown” in the primary prior art reference requiring rigidity to operate, and furthermore would require “a change in the basic principle under which” this primary reference “was designed to operate.” (MPEP 2143.01)

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 9

The teachings of Ratti and MPEP 2143.01 are particularly apt as to the present situation. McAlear requires indirect wireless communication in otherwise providing for the claimed invention, as has been described. Similar to the primary prior art reference in Ratti requiring rigidity to operate, the primary prior art reference McAlear requires indirect wireless communication to operate, whereas the claimed invention requires direct wireless communication. The principle of operation of McAlear is thus that indirect wireless communication is necessary, and combining Chan, which teaches direct wireless communication, with McAlear changes this principle of operation of the primary reference McAlear.

Furthermore, modifying McAlear with the teachings of Chan "would require a substantial reconstruction and redesign" of McAlear, which is also not allowed in Ratti and by the MPEP. For instance, the WAP gateway 260 by which indirect wireless communication between the resource and the mobile wireless console is achieved in McAlear encodes the data between the resource and the console "into a compact form that is more suitable for transmission over low speed wireless connections." (Col. 6, ll. 8-10) If McAlear were modified with Chan, then McAlear at worst might not work: the low speed wireless connections contemplated by McAlear might not be sufficient to handle the otherwise less, compact form of the data to be transmitted between the resource and the console. At best, McAlear would have to be reconstructed and redesigned substantially, so that, for instance, large amounts of data could still be sent between the resource and the console even over a low speed wireless connection. Thus, it is not a simple matter of combining McAlear with Chan, because doing so would destroy the principle of operation of McAlear. In sum, McAlear requires the use of indirect wireless communication, such that Chan is not properly combined with McAlear, where such a combination would require a substantial reconstruction and redesign of McAlear.

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 10

*Combining Chan with McAlear renders McAlear unsatisfactory for its intended purpose*

Third, black letter law states that “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP 2143.01, citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984)) A stated intended purpose of McAlear is its ability to allow wireless communication over low bandwidth wireless links, between a wireless console and a server. Thus, McAlear notes that

An advantage of the present invention is that of providing a measure of relief from the difficulty of handling data over a low bandwidth remote links . . . by providing linkage between data objects on one computer and applications residing on another computer without the objects needing to traverse the low bandwidth link.

(Col. 4, ll. 60-67) So the question is, how does McAlear achieve this intended purpose of providing for wireless communication over low bandwidth wireless links – and the answer is by using *indirect* wireless communication, via a WAP gateway. The WAP gateway encodes data “into a compact form that is more suitable for transmission over low speed wireless connections.” (Col. 6, ll. 8-10) Thus, if you eliminate the WAP gateway – as would be done by combining Chan with McAlear to achieve *direct* wireless communication instead of *indirect* wireless communication via the gateway – then you eliminate the very way McAlear achieves wireless communication over low bandwidth wireless links. But, if you eliminate McAlear’s way of achieving wireless communication over low bandwidth wireless links, then you have also rendered McAlear unsatisfactory for its intended purpose of relieving constraints in wirelessly communicating over such low bandwidth links. Therefore, modifying McAlear in view of Chan to achieve direct wireless communication is improper.

Claims 2-3

Claims 2 and 3 are dependent claims depending from claim 1, and therefore are patentable for at least the same reasons that claim 1 is patentable.

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 11

Claims 4-5

Claims 4 and 5 have been cancelled.

Claim 6

Claim 6 has been rejected under 35 USC 112, second paragraph, for being indefinite due to its inclusion of an offending limitation "essentially." Applicant has amended claim 6 to remove the limitation "essentially", and submits that it is now definite under 35 USC 112, second paragraph. Otherwise, claim 6 is a dependent claim depending from claim 1, and therefore is patentable for at least the same reasons that claim 1 is patentable.

Claim 7

Claim 7 is limited to the mobile wireless console managing the resource by performing "pre-boot management activities" related to the resource. Claim 7 has been rejected under 35 USC 103(a) as being unpatentable over McAlear in view of Nouri (6,330,690). First, claim 7 is patentable for at least the same reasons that claim 1 is, since it depends from claim 1. Second, Applicant contends that claim 7 is independently patentable, irrespective of the patentability of claim 1, for the reason now described.

Applicant submits that Nouri is not properly combined with McAlear, because it renders McAlear unsuitable for its intended purpose and changes the principle of operation of McAlear. In both cases, McAlear relates to wireless communications: McAlear's intended purpose is to achieve wireless communications between a wireless console and a resource, and its entire principle of operation for such communication between a console and a resource is wireless communication. However, Nouri requires the use of a "dial-in modem connection" to provide for the management of pre-boot activities of its resources. (See, e.g., Abstract, FIG. 1, and so on) As well known within the art, dial-in modem connections are inherently *wired*, not wireless,

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 12

connections. Both machines are connected via modems to a phone line, and one machine dials the other machine to establish a connection. (See, e.g., 276, 278, 280, 282, 286, and so on of FIG. 4A of Nouri) However, grafting on Nouri's modem-centric, and thus *wired*, approach to McAlear to allow for pre-boot activities to be managed by McAlear renders McAlear as having *wired* communications between a wireless console and a resource. However, if McAlear has *wired* communications between a wireless console and the resource, the whole crux of McAlear changes. McAlear is rendered unsuitable for its intended purpose, to achieve *wireless* communication between a *wireless* console and a resource. McAlear's principle of operation – wireless communication – is also notably changed. Therefore, Nouri is not properly combined with McAlear.

The question of course arises as to whether you can simply take the pre-boot management activities of Nouri and graft them onto McAlear in a wireless manner without using Nouri's wired, modem-centric approach. The answer is you cannot. The reason why is that Nouri teaches management of pre-boot activities by a console in a very specific way, by using a modem. To combine McAlear with Nouri means that McAlear is to be combined with the *teachings* of Nouri, and Nouri specifically *teaches* the management of pre-boot activities by using a modem, or wired communication. As has been stated above, a reference must be considered in its entirety. You cannot just take the pre-boot activities management of Nouri in isolation or in a vacuum, without considering *how* Nouri accomplishes such pre-boot activities management. Therefore, Nouri is not properly combined with McAlear, as Nouri teaches away from *wireless* communications pre-boot activities management, and instead teaches *wired* communications pre-boot activities management.

For instance, the Federal Circuit has stated that a prior art reference "must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (In re Spada, 15 USPQ2d 1655 (Fed. Cir. 1990)) Applicant's claimed invention here includes that pre-boot activities management is achieved via wireless

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 13

communication. Therefore, the prior art reference in question here, Nouri, has to teach pre-boot activities management via wireless communication, in order to be able to be combined with McAlear to yield the claimed invention obvious. However, Nouri does not teach pre-boot activities management via wireless communication, but via wired communication. Nouri thus has to be considered as a whole. Stripping off the pre-boot activities management part of Nouri and not including the wired communication part of Nouri in combining Nouri with McAlear is improper, because Nouri in this case would not "describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill . . . in possession of it," in contradistinction to the dictates of the Federal Circuit in Spada.

Indeed, to combine *just* the pre-boot activities management part of Nouri with McAlear, without considering Nouri as a whole as teaching pre-boot activities management in a wireless context, is to engage in permissible hindsight reconstruction of the claimed invention. As stated by the Federal Circuit,

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

(W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983)) That is, none of the cited prior art references teach the management of pre-boot activities by using wireless communication. To imbue one of ordinary skill in the art with such knowledge, then, when such knowledge is not found in the prior art references – e.g., Nouri teaches pre-boot activities management by using wired, not wireless, communication – is to engage in impermissible hindsight, as prohibited by the Federal Circuit.

Applicant provides one more reason why Nouri is not properly combined with McAlear. The Federal Circuit has stated that,

We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. . . . If references taken in combination would produce a "*seemingly inoperative device*," we have



Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 14

held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.

(McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001 (Fed. Cir. 2001) (Emphasis added) Combining McAlear with Nouri yields such a “seemingly inoperative device.” That is, McAlear’s intended purpose is to allow a *wireless* mobile console to communicate with a resource. Combining the *wired* communication approach of Nouri to allow this console of McAlear to manage pre-boot activities results in a nonsensical device: a “wireless” mobile console that nevertheless has to communicate in a wired manner to yield the claimed invention. But, a *wireless* mobile console cannot be wireless if it communicates in a wired manner! For this reason, too, combining McAlear and Nouri is improper.

#### Claims 8 and 9

Claims 8 and 9 are dependent claims depending from claim 1, and therefore are patentable for at least the same reasons that claim 1 is.

#### Claim 10

Claim 10 has been amended so that the protocol stack to which claim 10 is limited comprises the following:

- an application layer based on a wireless access environment (WAE) and supporting a micro-browser environment;
- a session layer based on a wireless session protocol (WSP) to provide the application layer with a consistent interface;
- a transaction layer based on a wireless transaction protocol (WTP) to provide a lightweight, transaction oriented protocol suitable for implementation in thin clients;
- a security layer based on a wireless transport layer security (WTLS) to provide data integrity, privacy, and denial-of-service protection;
- a transport layer based on a wireless data protocol (WDP) to provide a common interface to the security layer, the transaction layer, the session layer, and the application layer; and,
- one or more bearer layers, each providing a corresponding service.

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 15

Support for this amendment is found in the patent application as originally filed at least in FIG. 3 and its accompanying description in the specification.

Claim 10 has been rejected under 35 USC 103(a) as being unpatentable over McAlear in view of Chan. Claim 10 is a dependent claim depending from claim 1, and therefore is patentable for at least the same reasons that claim 1 is. However, Applicant also asserts that claim 10 is independently patentable, irrespective of the patentability of its base independent claim, claim 1. In particular, Applicant submits that the cited prior art does not teach, disclose, or suggest all of the added limitations to claim 10. That is, Applicant has reviewed the cited prior art of record, and cannot find the prior art as teaching the protocol stack as including an application layer, a session layer, a transaction layer, a security layer, a transport layer, and one or more bearer layers, as all of these layers are particularly recited in claim 10.

#### Claim 11

Claim 11 is an independent claim that has been rejected under 35 USC 102(e) as being anticipated by McAlear. Claim 11 has been amended to have at least one limitation similar to that of claim 1 – direct wireless communication between the mobile wireless console and the resource – and therefore is patentable for at least substantially the same reasons that claim 1 is patentable.

#### Claims 12-14

Claims 12-14 are dependent claims depending from claim 11, and therefore are patentable for at least the same reasons that claim 11 is patentable.

#### Claim 15

Claim 15 is an independent claim that has been rejected under 35 USC 102(e) as being anticipated by McAlear. Claim 15 has been amended to have at least one limitation similar to that of claim 11 – the means in the medium being able to “directly” communicate wirelessly with a

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 16

resource – and therefore is patentable for at least substantially the same reasons that claim 1 is patentable.

Claims 16-18

Claims 16-18 have been cancelled.

Claim 19

Claim 19 is limited to the management activities performed relative to the resource as being “pre-boot management activities.” Claim 19 has been rejected under 35 USC 103(a) as being unpatentable over McAlear in view of Nouri. First, claim 19, as a dependent claim depending from claim 15, is patentable for at least the same reasons that claim 15 is. Second, Applicant contends that claim 19 is independently patentable, irrespective of the patentability of claim 15. In particular, claim 19 has a substantially similar limitation to that of claim 7 – the management of pre-boot activities – and therefore is independently patentable for at least substantially the same reasons that claim 7 is patentable.

Claim 20

Claim 20 is a dependent claim depending from claim 15, and therefore is patentable for at least the same reasons that claim 15 is.

Fleshler  
Serial no. 09/884,596  
Filed 6/18/2001  
Attorney docket no. BEA920010006US1

---

Page 17

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



December 16, 2004  
Date

Michael A. Dryja, Reg. No. 39,662  
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja  
704 228<sup>th</sup> Ave NE #694  
Sammamish, WA 98074  
tel: 425-427-5094, fax 206-374-2819